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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/698,651

10/30/2003

Bennett Johnston

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7590 02/12/2007  
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EXAMINER

PIERCE, WILLIAM M

ART UNIT

PAPER NUMBER

3711

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/12/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/698,651

Applicant(s)

JOHNSTON, BENNETT

Examiner

William M. Pierce

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3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 21-25, 27, 28, 30-32, 34 and 36-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 21-25, 27, 28, 30-32, 34 and 36-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

WILLIAM M. PIERCE  
PRIMARY EXAMINER

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 21-25, 27, 28, 30-32, 34 and 36-43 are rejected under 35 U.S.C. 101 because the claimed invention is inoperative for the reasons set forth in the previous office action.

The disclosed invention is inoperative and therefore lacks utility. The episodic memory and the semantic memory systems are different and used differently from person to person. Persons do not have control over which systems of memory they resort to when facing a question or a problem. It is usually a combination memory systems in varying degrees depending upon the person. See the reference to Human Memory attached to this office action. For example, the question may be to list as many "rivers" as possible (from applicant's fig. 2). A player may answer from episodic memory based a rafting trip or his semantic memory based on his geography course. With regard to question and answer games in general, a player inherently uses all combinations of memory systems stimulated to a varying and unique degree that are necessary for them to use to formulate the best possible answer to the question or task before them. Another example would be from applicant's fig. 3, "the best vistas" could come from pictures in a history book or a past vacation depending upon the person and their state of mind when face with the question. To say that a particular question will only stimulate one, two, three or a combination of memory systems is not operative since such is dependent upon the person and their memory functions and not on the question.

Specifically using clams 20 and 34 to illustrate the examiner's position with respect to this grounds for rejection. Claim 20 recites "the performance of each unique task predictably requires retrieval of information from primarily one of a plurality of human memory systems and claim 34 recites how "direction calls for retrieval of information from memory using primarily a single first human memory system...second human memory system". Such recitations are inoperative since a person uses all facets of his memory in order to respond to a direction as they would deem to be appropriate. For example, whether a person uses information based upon a personal experience or based upon a fact memorized at school when reacting to a direction, is subjective. A direction is incapable of "calling" from a specific human memory system. Ultimately it is dependent upon the player's individuality which determines which part of his memory will be used. As such these claims are considered inoperative. Applicant's remarks in para. 6 and in the inventors memorandum have been considered but are deemed not persuasive. More specifically to the inventors memorandum he discusses the semantic memory system as on e the "contains conceptual and factual knowledge" and the episodic memory as that "must be recollected in the context of a particular time and place with reference to oneself as a participant in the episode". As set forth above, this is memory of a personal experience. To illustrate the examiner position that a direction cannot determine from which part of the human memory that a player will use, it is asked to consider the direction in the form of the question, "what color is the sky?" From elementary school science class one remembers that the sky is blue. So that would be the response. However, the same player or even another player from his episodic memory may remember camping one evening where the sky was pink. Depending upon the frame of mind of the player, the facet of his memory that is used is subjective and cannot be directed with any amount of predictability. As such the claimed invention is considered inoperative and remains rejected.

At the bottom of para. 6, applicant states that the control over which system of memory a player resorts to "is supplied by the structure of the game". However, this structure is NOT set forth in the claims. Nor is examples of this structure that is recited in the claims specifically pointed out. As such it cannot be relied on to distinguish over the applied art.

Appellant argues this grounds for rejection on the allegation that the examiner has not presented any evidence. To the contrary, as set forth above, the examiner attached a reference to the first office action entitled Human Memory. Reading the article for example on pg. 2 states that "semantic memory is derived from that in our

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own episodic memory". In light of the grounds for rejection taken by the examiner, appellant has not met his burden of showing where the examiner had erred. As such the grounds for rejection remains as set forth above.

***Claim Rejections - 35 USC § 112***

Claim 21-25, 27, 28, 30-32, 34 and 36-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 21 and 23, "the performance of each unique task", "the information from primarily a first hman memory system", "the plurality of human memory systems", "the information from primarily a second human memory system", "every position in the first path", "the game players" and "every position in the second path" lack a proper antecedent.

In claims 23 and 27, the meets and bounds of "information game players have no reason to remember the next day" is unclear in that it is subjective with no definite way to determine what a player will or will not remember the next day. As such there is no definite way to determine what type of information the claim is reciting.

In claim 25, "the memory of the game players", "the first human memory system" and "the second human memory system"

Claim 39 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not disclose moving the marker of another player when it occupies an intersection.

***Claim Rejections - 35 USC § 103***

Claims 21-25, 27, 28, 30-32, 34 and 36-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henry 4,714,255 in view of Alexander 6,279,909 as set forth in the previous office action;

As to claims, Henry shows a game board of intersecting first and second paths in combination with a plurality of collections of instructions in fig. 4 that stimulate the human memory. Inherently the player uses all of his memory systems, short-term, semantic and episodic memory systems, available to him based upon his individual ability in order to answer the question. Alternatively, while Henry factual trivia question, Alexander teaches that a mix of tasks, questions and actions can be in a trivia type game. To have added tasks such as that taught by Alexander would have been obvious in order to make the game more interesting to the players by offering a more variety of questions. With respect the applicant's use of the term "instructions" per se, broadly it has been held that the addition of instructions for how to use a device cannot impart patentability. See *In re Ngai (5/13/04)(Michel, Garjarsa, Linn)(per curiam)*.

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Further while Henry and Alexander fail to discuss the science behind the memory skills use in the answering of the game tasks, it has been clearly held that a property or a scientific explanation of the prior art's functioning does not negate the fact that the prior art inherently possessed the claimed element. "Insufficient prior understanding of inherent properties of a known composition does not defeat a finding of anticipation" *Atlas Powder Co. v. Ireco Inc.*, 19 F.3d 1342, 51 USPQ 2d 1943 (Fed. Cir. 1999).

With respect to paragraphs 4 and 5 of applicant's argument, they do not discuss limitations that are present in the above claims and are considered moot.

As to claims 20, 28, 32 and 40, such are considered apparatus claims. Alexander teaches a plurality of sets of cards 24, each of which bears a unique direction such as a question or a task to perform. The remaining limitations recited in the new apparatus claims of "the cards may be drawn..." and "the performance of each unique task..." fail to further limit the claimed invention by distinguishing over the applied art. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In *re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). As to claims 22, 29, 33 and 42, shown by Henry is a playing surface 1 marked with a plurality of indicia with a first path 2 and a second path 4 and markers in fig. 2. As to claim 23, 30 and 41, taught is a third set of cards in Alexander's 24. As to claims 24 and 31, Henry shows a plurality of intersections 20 on the playing surface that the players "may occupy". With respect to claim 25, no "means for" are recited and such is not interpreted as invoking 35 USC 112, sixth paragraph limitation requirements into this claim. As such the functional limitations as to what how the structure is to be used in playing the game to "require responses associated primarily with a single second human memory system" and "call for a second type of response" relates only to the printed matter and fails to distinguish over the applied art. More specifically to claim 25, the first and second "collection" is considered shown in the cards of Alexander in the cards as discussed above with respect to claim 20. What the "first directions call for" and how they "may be presented to game players" relates only to the intended method of use or play that fails to further distinguish this apparatus from the applied art. As to claim 26, the recited "game display" is considered to be the board 1 as set forth in claim 20 above with its first and second paths 2 and 4 respectively. Claim 27 is shown in the third cards as set forth above with respect to claim 23. In claims 34 and 43, Alexander teaches using different types of cards 24a with different types of directions that calls for a player to retrieve information from memory using the first human memory system. Further shown is a second direction 24b that allows a person to answer using a second human memory system. As to claim 35 and 36, fairly taught is first and second paths as set forth above with respect to claim 22. In Henry, the marker is moved along a path after responding to a question as called for in claims 37 and 38. As to claim 39, it is known to game to remove another marker of a player when it occupies the same space.

Applicant's arguments amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Applicant states that the applied art does not show more than one facet of human memory. In contrast, as set forth above, this rejection is based on inherency in that a player calls on all aspects of his memory systems in order to complete that tasks, questions and actions. As such, this grounds for rejection remains.

### **Conclusion**

Any inquiry concerning this communication and its merits should be directed to William Pierce at E-mail address [bill.pierce@USPTO.gov](mailto:bill.pierce@USPTO.gov) or at telephone number (571) 272-4414.


For official fax communications to be officially entered in the application the fax number is (703) 872-9306.

For informal fax communications the fax number is (703) 308-7769.

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Any inquiry of a general nature or relating to the **status** of this application or proceeding can also be directed to the receptionist whose telephone number is (703) 308-1148.

Any inquiry concerning the **drawings** should be directed to the Drafting Division whose telephone number is (703) 305-8335.

  
**WILLIAM M. BIESE**  
**PRIMARY EXAMINER**